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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/815,729	03/23/2001	George Harry Hoffinan	41556/03968 (RS11P010)	8183

22428 7590 08/02/2004

FOLEY AND LARDNER  
SUITE 500  
3000 K STREET NW  
WASHINGTON, DC 20007

EXAMINER

GORT, ELAINE L

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 08/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/815,729

Applicant(s)

HOFFMAN ET AL.

Examiner

Elaine Gort

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 1-6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 6/24/03; 10/24/03
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☒ Other: IDS: 9/7/01

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election without traverse of claims 7-18 in Paper No. 4/26/04 is acknowledged.

Claims 1-6 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 4/26/04.

### *Double Patenting*

2. Claims 7-18 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over all the claims filed in the following Applications because they are not patentably distinct:

09/815559  
09/815590  
09/815660  
09/815688  
09/815727  
09/815731  
09/815734  
09/815759  
09/815792  
09/815813  
09/815864  
09/815894  
09/815899  
09/816033  
09/816075  
09/816083  
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09/816495  
09/816503  
09/816507  
09/816536  
09/816555  
09/816560  
09/816561  
09/816567  
09/816582  
09/816881  
09/816922  
09/816944

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 7-18 are rejected because they lack patentable utility. Claims 7-18 merely claim the manipulation of data ("logic for" or "code for") but perform no concrete, useful or tangible result. One example of how this rejection may be overcome is by positively claiming the generation of a report or output of data.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**6. Claims 7-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shavit et al. (US Patent 4,799,156) in view of Troyer.**

Shavit et al discloses a system/computer program product for identifying goods in a network-based supply chain management framework comprising:

Logic for/Code for generating data at a plurality of stores of a supply chain utilizing a network (see figure 2 which shows buyers in communication with a networked supply chain system that is capable of receiving data from a store of a supply chain, for example the buyer/store enters information in a RFQ to obtain a quote/bid disclosed in column 13, lines 10+), the data relating to an ordering of goods required by the stores (column 6, line 21 discusses the system being used for "goods");

Logic for/Code for tagging the data with product identification (such as when the data is entered for a quote the data includes a description of the needed item, for example as a part number, see column 12 lines 63+);

Logic for/Code for communicating the data and the product identification to at least one of the supply chain participants utilizing the network, where the at least one supply chain participant is capable of using the data and the product or service identification for fulfillment of the order (data from the buyer is transmitted to the distributor to get a RFQ and also to place the order, see figure 2, column 13 lines 10+ and lines 51+; see also figure 2 and column 11, line 15+ regarding sellers (distributors) communicating concurrently with suppliers);

but Shavit et al. is silent regarding the use of numeric goods identifiers in the form of GTINs that are also positioned on the goods and are in the form of a bar code.

Troyer discloses that it is known in the art of supply chains to utilize numeric goods identifiers in the form of GTINs that are also positioned on the goods and are in the form of a bar code to provide integrated demand creation and demand fulfillment processes across all segments and also to provide an unambiguous and unique numbering system for food and related products at every point in the value network (product id bar coding is discussed on pages vii, 5 and 6; the use of GTINs are discussed on pages 1 and 4-11). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the system of Shavit et al. with numeric goods identifiers in the form of GTINs that are also positioned on the goods and are in the form of a bar code as taught by Troyer, in order to provide integrated demand creation and demand fulfillment processes across all segments and also to provide an unambiguous and unique numbering system for food and related products at every point in the value network.

### ***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elaine Gort whose telephone number is (703)308-6391. The examiner can normally be reached on Monday through Thursday from 7:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski, can be reached at (703)308-5183. The fax phone

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number for the organization where this application or processing is assigned is  
(703)305-7687.

Any inquiry of a general nature or relating to the status of this application or  
proceeding should be directed to the receptionist whose telephone number is (703)308-  
1113.

A handwritten signature in black ink, appearing to read 'Elaine Gort', with a stylized flourish at the end.

Elaine Gort  
Examiner  
3627

July 13, 2004